

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THEODORE I. KAMINS, YONG CHEN
and PATRICIA A. BECK

Appeal 2006-1826
Application 10/029,583
Technology Center 1700

Decided: January 31, 2007

Before BRADLEY R. GARRIS, PETER F. KRATZ, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1). In particular, we remand this application to the Examiner to clarify the record as to the propriety of the previously indicated entry of the Reply Brief filed on December 22, 2005 with the continuation of this appeal. The Examiner is required to take action in furnishing an appropriate

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response to this Remand in light of the evidence cited at pages 3, 4, and 6 of the Reply Brief, as indicated below.

37 CFR § 41.41(2005) states in relevant part:

- (a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.
- (2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence...
- (b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

Yet, in the communication dated March 01, 2006, the Examiner merely stated:

The reply brief filed December 22, 2005 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

The Examiner did not notify the Appellants that their Reply Brief was not in compliance with 37 C.F.R. § 41.41(a)(2005) for citing new evidence at pages 3, 4, and 6 thereof, if such is the case. Alternatively, if such evidence is not new to the record, the Examiner did not require Appellants to identify the referred to evidence as having been previously entered. Nor did the Examiner otherwise indicate the status of the cited evidence mentioned in the Reply Brief and respond to the Appellants' arguments utilizing the evidence furnished in the Reply Brief.

Thus, we remand this application to the Examiner to clarify the record as to the status of the evidence furnished with the Reply Brief and appropriately respond thereto. In this regard, we note that the Evidence

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Appendix attached to the Brief indicates no evidence is being relied upon by Appellants therein. Thus, if the evidence furnished with the Reply Brief is new to the record of this application, the Examiner must:

- 1) Notify the Appellants that the Reply Brief is not in compliance with 37 CFR § 41.41(a)(2005) so that Appellants have an opportunity to comply with the Rule; and provide, upon compliance with the Rule, a Supplemental Answer furnishing a complete response addressing any new arguments directed to the appealed claims submitted in a compliant Reply Brief; or, in the alternative;
- 2) Reopen prosecution if the Examiner desires to enter and consider new evidence furnished with a paper styled as a "Reply Brief."

This application, by virtue of its "special" status, requires an immediate action on the part of the Examiner. *See MPEP* § 708.01 (8th ed., Rev. 5, August 2006).

This Remand to the Examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board.

REMAND

clj

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